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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/995,287  
Filing Date: November 26, 2001  
Appellant(s): BLY ET AL.

**MAILED**

**DEC 20 2006**

**GROUP 3600**

Michael B. Stewart, Reg. No. 36,018 and Charles A. Bienman, Reg. No. 51,472  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3 October 2006 appealing from the  
Office action mailed on 29 March 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,915,973	HOEHN-SARIC et al.	6-1999
6,148,297	SWOR et al.	11-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Response to Amendments/Arguments**

Applicant is of the opinion that the combined prior art does not teach the claimed method, system and device. Specifically, Applicant asserts that Swor et al. do not disclose a wireless device, while Hoehn-Saric et al. do not teaching prompting a question for a respondent wherein the prompting occurs independent of a communication link between a wireless device and the wireless infrastructure. The Examiner respectfully disagrees. Swor et al. teach a portable unit such as a personal digital assistant (column 4, lines 45-67; column 5, lines 13-17) used for safety education where education comprises certification courses and tests (column 5, lines 33-44). To one of ordinary skill the portable digital assistant or any of the portable units are wireless as they contain modems and are for use in vehicles such as a mobile blood collection vehicle (column 4, lines 45-52). Hoehn-Saric et al. teach prompting a user for a question. Hoehn-Saric et al. teach authenticating a user, then if the user is authenticated sending the user

test questions (column 8, lines 52-55). Hence, prior to authentication, the user does not see the test questions, therefore, the Examiner regards the appearance of the test questions before the user as "prompting" as it moves the user to action ("prompt" is defined as "to move to action", Webster's Ninth New Collegiate Dictionary). Hoehn-Saric et al. also teach prompting a question for a user independent of a communication link between a remote testing device (figure 1, item 3) and data link that allows for communication between the central station and the remote device (figure 1, items 1 and 3; column 5, lines 19-40).

Specifically, after authentication test questions are downloaded to the user at the remote testing device (column 8, lines 52-55) and once the test is completed the user uploads the completed exam back to the central station (column 9, lines 3-4). In order to take the test the remote device is not in continuous communication with central station (i.e. test source), therefore, even if the data link is down (figure 1, items 1 and 3), the user will still be prompted to answer the first question as the questions are stored at the remote device (column 8, lines 52-55; column 9, lines 3-4). To one of ordinary skill, the benefits of combining the two teachings are clear, as the implementation of user authentication ('973, column 8, lines 52-55) to the Hoehn-Saric et al. system will ensure that the person being certified and the test taker are one and the same ('297, column 5, lines 33-44). Regarding the type of questions asked, both Hoehn-Saric et al. (column 1, lines

5-11) and Swor et al. (column 5, lines 34-44) are directed to test taking therefore it would have been obvious to one of ordinary skill to use the teachings of Hoehn-Saric et al. (column 8, lines 52-55) to administer any test independent of subject matter.

Claim 36 was also rejected under 112 2<sup>nd</sup> paragraph. It has been held that claims are to be precise, clear, correct, and unambiguous (In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Claim 36 is directed to utilizing a wireless communications system having a wireless infrastructure and a wireless device, however, claim 36 also recites prompting a question to a use independent of an active communication link between the wireless device and the wireless infrastructure. Therefore, it is not clear to one of ordinary skill whether or not the wireless communication system having a wireless infrastructure and a wireless device is actually utilized. Claim 39 was also rejected under 112 2<sup>nd</sup> paragraph. Applicant attempts to overcome the rejection by citing paragraphs from the Specification (paragraphs [0079] and [0096]), however these passages are silent regarding new questions and updating questions therefore, the Examiner maintains the rejection to claim 39. Claims 43, 44, 52, 53, 61, and 62 also remain rejected as it is unclear whether the step of "responding", for example, in claims 36, 46 and 55, occur if it is determined that the question does not need to be prompted.

Regarding the objection to claim 43, claim 36 requires a step of "prompting... a question". Claim 43, on the other hand recites "determining if the question is required to be prompted". This is conditional language (i.e. determining if), hence if it has been determined that a question *is not* required to be prompted, according to the MPEP (MPEP 608.01(n)) claim 43 would not then further limit claim 36, as any actions that proceed from the question being prompted (e.g. "receiving a response to the question") would not occur. Claims 44, 52, 53, 61 and 62 also remain objected to.

The Applicant did not sufficiently challenge the Examiner's assertion of facts therefore the following is considered admitted prior art:

- updating of exam questions, for example by changing questions, in order to introduce new topics, emphasize or de-emphasize material, and the memorization of questions
- data cannot be communicated successfully from one device to another unless there is a connection between the two

### ***Claim Objections***

Claims 43, 44, 52, 53, 61, and 62 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 43 recites "determining if the question is required to be prompted". However, claim 36, from which claim 43 depends, specifies prompting a question to a user. Hence, claim 43 does not further limit its parent claim as it makes optional a required limitation of claim 36. Claims 44, 52, 53, 61, and 62 are also objected to as it recites similar language.

### ***Claim Rejections - 35 USC § 112***

Claims 36-62 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 36 is directed to a method "utilizing a wireless communication system having a wireless infrastructure and a wireless device" however, the second claimed limitation is directed to performing a "prompting" without utilizing the wireless communication system as the action is performed "independent of



an active communication link between the wireless infrastructure and the wireless device". Claims 46 and 55 recite similar language. Therefore, it is not clear to one of ordinary skill what is Applicant's claimed method and the scope of said method.

Claims 37-45, 47-54, and 56-62 are also rejected as they depend from claims 36, 46 and 55, respectively.

b. Claim 39 recites "receiving a new question by the wireless device from the wireless infrastructure and updating the questions". To one of ordinary skill, this is unclear as a "new" question replaces an "old" question one, while updating a question may result in only a slight modification.

c. Claim 43 recites "determining if the question is required to be prompted". However, claim 36, from which claim 43 depends, specifies prompting a question to a user. Therefore, according to the language of claim 36, it has already been determined that the operator has answered in the affirmative regarding "prompting". Claims 44, 52, 53, 61, and 62 are also rejected as each recites similar language to claim 43.

***Claim Rejections - 35 USC § 103***

Claims 36-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swor et al., U.S. Patent No. 6,148,297 in view of Hoehn-Saric et al., U.S. Patent No. 5,915,973.

As per claims 36, 43, 44, 46, 52, 53, 55, 61 and 62, Swor et al. teach a worker certification system comprising receiving a response and storing a response to a question (column 5, lines 33-45) utilizing a wireless communication system (i.e. wireless device and infrastructure) (column 4, lines 45-52). However, Swor et al. do not specifically disclose receiving an identifier from a test taker. Hoehn-Saric et al. teach a test taking system where the system receives an identifier from a test taker (column 8, lines 23-29). Hoehn-Saric also teach prompting a question independent of an active communication link as the questions are downloaded to and stored by the test taking device (column 8, lines 52-56). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Swor et al. and Hoehn-Saric et al. to validate the test taker in order to prevent fraud ('973, column 8, lines 25-55).

As per claim 37, 47 and 56, Swor et al. teach a wireless communication system (column 4, lines 45-52) for certifying workers comprising the storing of responses to questions (column 5, lines 33-45). In wireless communication, it is well known that data cannot be communicated successfully from one device to another unless there is a connection between the two. Swor et al. discloses a scoring module for evaluating responses (column 5, lines 40-45). However, Swor

et al. do not specifically recite the location of said module. Hoehn-Saric et al. teach forwarding completed questions to a central location (column/line 8/65-9/5). Therefore, it would have been obvious of one of ordinary skill to combine the teachings of Swor et al. and Hoehn-Saric et al. in order to reduce the prospects of test taker fraud by evaluating the responses at a remote location.

As per claim 38, Swor et al. teach certification (column 5, lines 35-45) and Hoehn-Saric et al. teach associating and storing identifiers with responses (column 9, lines 37-58). Regarding an identifier having "temporal relationship to other identifiers", this is non-functional descriptive material as the type of identifier does not alter how Applicant's process steps are to be performed to achieve the utility of the claimed invention (MPEP 2100-22). Nonetheless, it is well known to those of ordinary skill to use identifiers for establishing a temporal relationship between responses.

As per claim 39, 48, and 57, the Examiner takes Official Notice of the updating of exam questions, for example by changing questions, in order to introduce new topics, emphasize or de-emphasize material, and the memorization of questions.

As per claims 40-42, 45, 49-51, 54, 58-60, Swor et al. and Hoehn-Saric et al. disclose examinations (i.e. tests). Therefore, claim language that specifies the type of questions is non-functional descriptive material as the type of questions

does not alter how Applicant's process steps are to be performed to achieve the utility of the claimed invention (MPEP 2100-22).

### **(10) Response to Argument**

#### **112 Second Paragraph**

The Examiner withdraws the rejection to claims 39.

#### *Claims 36-72*

Appellant is of the opinion that the Examiner has not sufficiently explained the basis for the 112 second paragraph rejection applied to claims 36, 46 and 55. The Examiner respectfully disagrees. In the "Response to Amendments/Arguments" and "Claim Rejections - 35 USC § 112 section" of the Final Office action dated 3-29-06 (see also above) the Examiner clearly stated that claims 36, 46 and 55 as they are written are not "precise, clear, correct, and unambiguous (In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989))" because each claim is directed to both *utilizing a wireless communications system having a wireless infrastructure and a wireless device* (preamble claims 36, 46 and 55), and "prompting, *independent of an active communication link between the wireless device and the wireless infrastructure, a*

question related to operational status of the asset for the operator" (second limitation claims 36, 46 and 55) (emphasis added). To one of ordinary skill, therefore, Appellant has not clearly defined the claimed method as the method operates *independent* of an active link between the components of the wireless communication system (i.e. the wireless infrastructure and the wireless device). In other words, the wireless communications system is not actually *utilized* as the preamble asserts.

*Claims 43, 44, 52, 53, 61 and 62*

Appellant is of the opinion that the Examiner has not clearly pointed out the reason for the rejection of claims 43, 44, 52, 53, 61 and 62 under 112 second paragraph and should be reversed based on "lack of clarity" (Appeal Brief, page 16, section 3). The Examiner respectfully disagrees. In the "Response to Amendments/Arguments" and "Claim Rejections - 35 USC § 112 section" of the Final Office action dated 3-29-06 (see also above) the Examiner clearly established the rationale for making the rejection. Specifically, claim 43 (for example) recites "determining *if* the question is required to be prompted" (emphasis added) while claim 36 from which claim 43 depends recites "*prompting*, independent of an active communication link between the wireless device and the wireless infrastructure, *a question related to operational status of the asset for the operator*" (emphasis added). The presence of the term "if" in dependent claim 43 indicates to one of ordinary skill that the prompting of a question may or may not occur hence claim 43, along with claims 44, 52, 53, 61, and 62 are indefinite (note: the

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Examiner also objected to claims 43, 44, 52, 53, 61, and 62 for not further limiting their respective dependent claims).

### 103 Rejections

A chart mapping the prior art of Swor et al. and Hoehn-Saric et al. to Appellant's broadest claim.

Claim 36

Swor et al.- US Patent No. 6,148,297 and  
Hoehn-Saric et al.- U.S. Patent No.  
5,915,973

A wireless infrastructure and a wireless device associated with an asset...

"The system comprises a substantially **portable unit such as a portable computer, a handheld processor, or a personal digital assistant**. Preferably the **unit 32 contains means such as a modem 325 for communicating with a central processor 14 such as might be located at a home base...**" ('297, column 4, lines 45-59)

Receiving an operator identifier from an operator of the asset

"Otherwise, the prompt is given on display 32 of the remote testing site 3 **and card information may either be entered by the registrant with input 33, or a special input, such as a card reader...** If the **card is determined to be valid** at step 61, and the **test taker is verified as a valid registrant...** and **the test taker is asked**

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**to enter biometric data...** ('973, column 8, lines 25-33).

Explanation:

In Swor et al. the asset is the portable computer ('297, column 4, lines 45-58) used to take the test ('297, column 5, lines 35-52), whereas in Hoehn-Saric et al. it is the test-taking kiosk ('973, abstract).

**"The system comprises a substantially portable unit such as a portable computer, a handheld processor, or a personal digital assistant. Preferably the unit 32 contains means such as a modem 325 for communicating with a central processor 14 such as might be located at a home base..."** ('297, column 4, lines 45-59)

Prompting, ***independent of an active communication link between the wireless device and wireless infrastructure...***

A third topic comprises safety education... which presents the user with a choice 648 between certification courses, ***and tests...*** ***When the user has taken a test*** 643, which ***is done interactively using methods well known in the art*** ('297, column 5, lines 34-42). Note: To one of ordinary skill interactive test taking encompasses ***"prompting"*** such as an indication to "go to the next page" or "start the test"

Hoehn-Saric et al. teach prompting ***independent of an active communication link between the wireless device and wireless infrastructure***, as Hoehn-Saric et

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al. disclose "test question data is communicated to the remote test site" ('973, column 8, lines 55-58) and "After all the questions have been answered (step 73) the test taker is given the option of reviewing the questions (step 74), or completing the test (step 76). In step 77 a unique identifier is assigned to the testing event... Thereafter, the test response data is communicated to the central station 1 at step 78" ('973, column/line 8/65-9/4). Where Hoen-Saric et al. identify the link between the remote test site (wireless device) and the remote center can be over any communication link such as via satellite (e.g. wireless) ('973, column 5, lines 19-24)

Explanation: Once the questions are downloaded to the site the test taker takes the test based on the downloaded questions hence, the status of the active connection between the device and wireless infrastructure that enabled the test to be downloaded is immaterial and does not affect the user's ability to take the downloaded test.

**a question** related to operational status of the asset for the operator

Explanation:

Both Swor et al. and Hoehn-Saric et al. are directed to test taking. The type of question asked or the subject matter of the question has no effect on the steps of "receiving", "prompting", "receiving" and "storing".



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Receiving a response to the question

When the user has *taken a test 643, which is done interactively using methods well known in the art the answers are routed* to a scoring module 644, which displays the test results to the user and transmits them to the central processor. If the score is satisfactory, the scoring module 644, also grants certification on the selected subject matter ('297, column 5, lines 34-44)

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Storing the response

When the user has ***taken a test 643, which is done interactively using methods well known in the art the answers are routed*** to a scoring module 644, which displays the test results to the user and transmits them to the central processor. If the score is satisfactory, the scoring module 644, also grants certification on the selected subject matter ('297, column 5, lines 34-44)

Explanation: The test is conducted interactively using a computer therefore in order to score the test, the answers have to be recorded or stored in computer memory as the computer would not have access to a paper record according to the teachings of Swor et al..

*Motivation to combine*

Regarding the combination of Swor et al. and Hoehn-Saric et al., Appellant asserts that one of ordinary skill would not have any reason, beyond hindsight, to combine the two teachings to arrive at Appellant's method (Appeal Brief, pages 17 and 18) citing for example In re Oetiker. However, according to In re Oetiker (24 USPQ2d 1443, CAFC 1992) references are selected as being reasonably pertinent to the

problem based on the judgment of a person having ordinary skill in the art, that is to say, "it is necessary to consider 'the reality of the circumstances,'—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." (*In re Oetiker*, 24 USPQ2d 1443, CAFC 1992; *In re Wood*, 202 USPQ 171 (C.C.P.A. 1979)). *In re Khan* (78 USPQ2d 1329, (CAFC 2006)), on the other hand, clearly establishes an Examiner's requirements for combining references under 103,

"motivation-suggestion-teaching" test asks not merely what references disclose, but whether person of ordinary skill in art, possessed with understandings and knowledge reflected in prior art and motivated by general problem facing inventor, would have been led to make claimed combination, and from this it may be determined whether overall disclosures, teachings, and suggestions of prior art, and level of skill in art, support legal conclusion of obviousness.

Swor et al. and Hoehn-Saric et al. both teach test taking ('297, column 5, lines 34-52; '973, abstract). Swor et al. is directed to the certification of health-care staff and occupational safety of a health-care facility such as a hospital or a blood bank ('297, column/line 3/60-4/10; column 5, lines 25-30), while Hoehn-Saric et al. are directed to test taking in general ('973, abstract). To one of ordinary skill, it is important for managers and owners of hospitals or other health-care facilities to ensure that employees are certified to perform emergency and operating room tasks and roles, if only to protect the facility against lawsuits. Swor et al., however, do not provide for the authentication of test-takers. Hoehn-Saric et al. solves this problem by authenticating

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test-takers using unique test-taker data such as biometric data ('973, column 8, lines 25-44). Hence, the combination of Swor et al. and Hoehn-Saric et al. prevents uncertified and untrained persons ('297, column 5, lines 25-30) from operating in emergency and high-risk health-care facilities ('297, column 4, lines 15-29).

*"receiving an operator identifier from an operator of the asset*

Both Swor et al. and Hoehn-Saric et al. are directed to test taking. To one of ordinary skill, the asset is the portable computer ('297, column 45-59) or kiosk ('973, abstract) and the operator of the asset is the test taker. Hoehn-Saric et al. teach receiving card and biometric data (i.e. operator identifier) of a test-taker (i.e. operator) in order to determine that the test-taker is a valid registrant, therefore, the prior art teaches *receiving an operator identifier from an operator of the asset* ('973, column 8, lines 25-33).

*a question related to operational status of the asset for the operator*

Appellant is attempting to differentiate the claimed method from the prior art based on the type of question asked or the subject matter of the question. However, as the question does not effect the operation of the method or more specifically the steps of "receiving", "prompting", "receiving" and "storing". The fact that both Swor et al. and Hoehn-Saric et al. are directed to test taking is sufficient in terms of art as the questions

although stored are not functionally related to the claimed asset, wireless device or wireless infrastructure (In re Ngai, 70 USPQ2d 1862 (Fed. Cir. 2004)).

*Claims 37, 47 and 56*

The Examiner took Official Notice that, [in] wireless communications, *it is well known that data cannot be communicated successfully from one device to another unless there is a connection between the two*. An assertion of fact that has gone unchallenged by Applicant. Therefore, to one of ordinary skill, the subject matter of claims 37, 47 and 56 are at least obvious, if not inherent. As an example, the Examiner would the Board to consider sending e-mail via a laptop that connects wirelessly to the internet. When an individual attempts to said an email message using said laptop, the laptop first looks for an internet access point, and if it is found the message is transmitted, otherwise is not sent. In the context of the prior art of Hoehn-Saric et al., one of ordinary skill would infer that responses would be transmitted if there was a connection and not transmitted if there wasn't one connection ('973, column/line 8/65 94).

*Claim 38*

Appellant is of the opinion that the prior art of Swor et al. and Hoehn-Saric et al. do not teach "assigning an identifier to the response, and storing the identifier in relation to the response". More specifically, Appellant asserts that Swor et al. and Hoehn-Saric

et al. teach away from an assigning an identifier (Appeal Brief, page 22, section b). Swor et al. and Hoehn-Saric et al. teach test-taking ('973, abstract; '297, column 5, lines 33-44), in both Swor et al. and Hoehn-Saric et al. test results are associated with a user and/or unique identifier ('297, column 5, lines 33-44; '973, column 8, lines 15-51, column/line 8/65-9/4). Therefore, as the Appellant has not claimed assigning a unique identifier to each response, a single identifier assigned to the set of responses is sufficient to read on the claims and is a feature taught by the prior art ('297, column 5, lines 33-44; '973, column 8, lines 15-51; column/line 8/65-9/4). From Appellant's comments, Appellant appears to assert that Appellant is the first to number questions on a test (Examiner's broadest reasonable interpretation) as "... neither [Swor et al. and Hoehn- Saric et al.] would have had any reason to assign an identifier to a response or store the identifier in relation to the response" (Appeal Brief, pages 22-23, section b). The Examiner's experiences as a student, graduate student and teaching assistant necessitates that the Examiner respectfully disagrees.

*Claims 40-42, 45, 49-51, 54, and 58-60*

Again, Appellant is attempting to differentiate the claimed method from the prior art based on the type of question asked or the subject matter of the question. However, as the question does not effect the operation of the method or more specifically the steps of "receiving", "prompting", "receiving" and "storing". The fact that both Swor et al. and Hoehn-Saric et al. are directed to test taking is sufficient in terms of art as the

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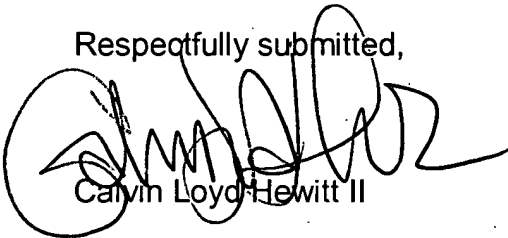
questions although stored are not functionally related to the claimed asset, wireless device or wireless infrastructure (In re Ngai, 70 USPQ2d 1862 (Fed. Cir. 2004)).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Calvin Loyd Hewitt II

Conferees:

Vincent Millin



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